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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,255	01/03/2002	Jeffrey N. Eisen	23452-147	9427
909	7590	04/27/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			PAULA, CESAR B	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			2178	
DATE MAILED: 04/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,255

Applicant(s)

EISEN, JEFFREY N.

Examiner

CESAR B. PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment filed on 1/27/2005.

This action is made Final.

2. In the amendment, claim 23 has been added. Claims 1-23 are pending in the case. Claims 1, 8, 15, and 23 are independent claims.

Drawings

3. The drawings filed on 1/3/2002 have been approved by the Examiner.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-22 remain, and 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (USPub.# 2003/097361, 5/22/2003, filed on 6/15/1999), in view of Barnes, Kate, hereinafter Barnes, "10 Minute Guide to Windows 3.1", Sams, 1992, p. 60-65.

Art Unit: 2178

Regarding independent claim 1, Huang discloses a user using checkboxes for selecting files—*documents--* to be attached to an email from a window display—*summary view--* (0084, and fig. 7A).

Moreover, Huang discloses that the user clicks on a button to attach the selected files to the email—*receiving instructions from the user to create a list of one or more selected*. An email window 720 then appears having the selected files —*creating a list of the one or more selected documents and storing them--* (0084, and fig. 7A).

Furthermore, Huang teaches the display of the selected files along with an email recipient's information, icons, and underlining, hyperlinking the file name—*document summary data--* to the file itself—*summary view--* (0084-0085, and fig. 7A-7B). Huang fails to explicitly disclose: *store the list in a system clipboard*. However, Barnes teaches the copying of information using Windows system clipboard (page 60, lines 4-9, 15-19). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Huang, and Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, utilizing the copying process, so that the user is able to use those files without loss or damaging these files.

Regarding claim 2, which depends on claim 1, Huang the display of the selected files along with an email recipient's information, icons, and underlining, hyperlinking the file name—*document summary data--* to the file itself—*summary view--* (0084-0085, and fig. 7A-7B).

Art Unit: 2178

Regarding claim 3, which depends on claim 1, Huang the display of the selected files along with an email recipient's information, icons, and underlining, hyperlinking the file name—*document summary data--* to the file itself—*summary view--* (0084-0085, and fig. 7A-7B).

Regarding claim 4, which depends on claim 1, Huang the display of the selected files along with an email recipient's information, icons, and underlining, hyperlinking the file name—*document summary data--* to the file itself—*summary view--* (0084-0085, and fig. 7A-7B).

Huang fails to explicitly disclose: *documents that are found by an Internet search engine*.

However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have used the search engine to obtain the documents, because Huang teaches that it is often cumbersome to extract items in received email items in a database, and effectively assisting a user in receiving, and manipulating information (0007-0008). This provides the benefit of making it easier for a user to retrieve documents from an Internet database.

Regarding claim 5, which depends on claim 1, Huang the display of the selected files along with an email recipient's information, icons, and underlining, hyperlinking the file name—*document summary data--* to the file itself—*summary view--* (0084-0085, and fig. 7A-7B).

Huang fails to explicitly disclose: *documents that are found in a discussion thread*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have used documents in a discussion thread, because Huang teaches effectively assisting a user in receiving, and manipulating information (0008). This provides the benefit of making it easier for a user of a bulletin board of manipulating messages being sent, and included in a thread.

Art Unit: 2178

Regarding claim 6, which depends on claim 1, Huang discloses the selection of files displayed on the screen checking a checkbox associated with each of the displayed files (0084-0085, and fig. 7A).

Regarding claim 7, which depends on claim 1, Huang the display of the selected files, in a line or row labeled attachment and each of the files in two columns next to each other, along with an email recipient's information, icons, and underlining, hyperlinking the file name—*document summary data*-- to the file itself—*summary view*-- (0084-0085, and fig. 7A-7B). --*table inserting the summary data and the hyperlinks* etc. (0084-0085, and fig. 7A).). Huang fails to explicitly disclose: *storing the table in a system clipboard*. However, Barnes teaches the copying of information using Windows system clipboard (page 60, lines 4-9, 15-19). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Huang, and Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, so that the user is able to use it without loss or damaging these files.

Claims 8-14 are directed towards a computer system for implementing the steps found in claims 1-7 respectively, and therefore are similarly rejected.

Claims 15-21 are directed towards a computer readable medium for storing the steps found in claims 1-7 respectively, and therefore are similarly rejected.

Art Unit: 2178

Claim 22 is directed towards a computer signal embodied in a computing system for implementing the steps found in claim 1, and therefore is similarly rejected.

Regarding independent claim 23, Huang discloses a user using checkboxes for selecting files—*documents--* to be attached to an email from a window display—*summary view--* (0084, and fig. 7A).

Moreover, Huang discloses that the user clicks on a button to attach the selected files to the email—*receiving instructions from the user to create a list of one or more selected*. An email window 720 then appears having the selected files —*creating a list of the one or more selected documents and storing them--* (0084, and fig. 7A).

Furthermore, Huang teaches the display of the selected files along with icons, and underlining, file name, and hyperlinking the file name— *wherein the summary data pertaining to the selected document includes all summary data pertaining to the selected document that was included in the summary view--* to the file itself—in the *summary view--* (0084-0085, and fig. 7A-7B). Huang fails to explicitly disclose: *store the list in a system clipboard*. However, Barnes teaches the copying of information using Windows system clipboard (page 60, lines 4-9, 15-19). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Huang, and Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, utilizing the copying process, so that the user is able to use those files without loss or damaging these files.

Response to Arguments

6. Applicant's arguments filed 1/27/2005 have been fully considered but they are not persuasive. Regarding claims 1, 8, and 15, the Applicant states that Barnes has no teaching, suggestion, or motivation to modify Huang, and disagrees with the rejection of these claims, that says that Huang teaches the list has hyperlinks to the documents included in the list (pages 7-8). The Examiner disagrees, because Huang teaches the display of the selected files along with an email recipient's information, icons, and underlining, hyperlinking the file name—*document summary data--* to the file itself—*summary view--* (0084-0085, and fig. 7A-7B). In other words, the selected files are hyperlinked to the summary document, as recited in the claims, so that by clicking on the hyperlink the complete linked file is retrieved. Huang fails to explicitly disclose: *store the list in a system clipboard*. However, Barnes teaches the copying of information using Windows system clipboard (page 60, lines 4-9, 15-19). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Huang, and Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, through the copying process, so that the user is able to use it without loss or damaging these files.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2178

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-2148. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

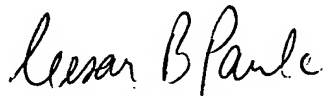
Any response to this Action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

- (703) 703-872-9306, (for all Formal communications intended for entry)

Hand-delivered responses should be brought to Randolph, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).


CESAR PAULA
PRIMARY EXAMINER

4/20/05